

### REMARKS/ARGUMENTS

Claims 1-20 are pending in the application. Applicants respectfully request reconsideration of the rejections set forth in the Final Office Action dated January 27, 2005 in light of the following remarks.

#### Rejections Under 35 U.S.C. §102/103

Claims 1-2, 5-6, 9-10, 13-17, and 20 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,978,029 to Boice et al. ('Boice'). Claims 3-4, 7-8, 11-12, and 18-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boice in view of U.S. Patent No. 6,026,232 to Yogeshwar et al. ('Yogeshwar'). Applicants respectfully traverse.

Independent claims 1, 6, 10, 15, and 16 were rejected under §102 using Boice. Independent claims 1, 6, 10 and 16 recite "wherein a frame with low complexity is selected as an I frame in the modified video stream if the scene change is a fade." Independent claim 15 recites "if a fade has occurred, utilizing means to select a frame with low complexity in the fade as an I frame in said video stream."

Boice doesn't describe selecting a frame with low complexity as an I frame. The portion of Boice used by the Examiner in the latest Office Action (fig. 9, 620-660-540) is particularly silent on this limitation. In contrast, the text for Fig. 9 of Boice details the control processor 520 of fig. 8, while steps 620-660-540 describe resetting parameters (such as the quantization step size) if there is a scene change. The reference does not teach "selecting a frame with low complexity as an I frame" as recited. And the Examiner has not pointed to text in Boice that remotely describes this limitation.

Instead, the Examiner *infers* this limitation into the reference "it is considered ..." (See page 2 of the latest Office Action) using the figure. First, MPEP Section 2131.01 states "To anticipate a claim, the reference must teach every element of the claim". Since the reference does not describe or suggest the limitation, rejection under §102 is no longer proper. This is proven by the Examiner's need to use an **inference**. A creative inference cannot cure a lack of teaching of a reference under §102. Second, the claims also mention selection, which is still outside of the Examiner's "it is considered ..." assertion. More specifically, the reference and Office Action fail to point out where, whether and how the selection occurs. Rejection under §102 is thus no longer proper

Boice also cannot be extended to suggest the independent claims, as the Examiner attempts to do. Boice aims to reduce bit rate. However, the Examiner takes Official Notice (see page 3 of the Office Action) that "B frames require the least amount of bits to code when compared to I and P frames". Converting a B or P frame to an I frame (the Examiner's "it is considered ...") using Boice would a) **raise the bit rate** according to the Examiner's own Official Notice, and b) thereby **teach against bit rate reduction** as intended by Boice. In other words, the inference ("it is considered ...") contradicts - and is defeated by - his own Official Notice.

Thus, not only is the inference ("it is considered ...") not taught by the reference, it teaches against bit rate reduction - and is disposed by the Examiner's own Official Notice. Clearly, Boice does not teach what the Examiner inferred, and the reference does not teach or suggest the claimed invention.

For at least these reasons, Boice does not teach or suggest independent claims 1, 6, 10, 15, and 16 and the independent claims are allowable.

Yogeshwar does not correct for deficiencies in Boice, and similarly does not teach or suggest the independent claims and selecting a low complexity frame as I frame if the scene change is a fade. Yogeshwar does not even mention fades.

Dependent claims 2-7, 9-21, 23-30, 32-39 and 41-46 each depend directly from independent claims 1, 8, 22, 31 and 40, respectively, and are therefore respectfully submitted to be patentable over Boice and/or Yogeshwar for at least the reasons set forth above with respect to the independent claims. Further, the dependent claims recite additional elements which when taken in the context of the claimed invention further patentably distinguish the art of record. For example, dependent claims 5, 9, 13, and 20 recite using a "lowest complexity" frame as an I frame. Neither Boice nor Yogeshwar teach or suggest selecting a low complexity frame, not to mention a "lowest complexity" frame.

Withdrawal of the rejections under 35 USC §102(b) and §103(a) are therefore respectfully requested.

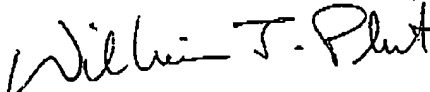
The Examiner took official notice that B frames require the least amount of bits to code when compared to I and P frames. According to MPEP Section 2144.03.D, Applicants request the Examiner to produce adequate evidence for this feature if it is claimed as well known (as the MPEP states, if it is well known, it should not be difficult to find support). In particular, to produce evidence that it is well known that B frames require the least amount of bits to code when compared to I frames.

Applicants believe that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Response is to be charged to Deposit Account No. 50-0388 (Order No. CISC255).

Respectfully submitted,

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Limited Recognition under 37 C.F.R. §10.9(b)

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